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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/884,095
Filing Date: June 19, 2001
Appellant(s): BLOCHER ET AL.

IBM
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/31/2007 appealing from the Office action mailed 6/1/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Pram It or Walk Away

Neal S. Gray

Transactions of AACE

International; pp. r5-48;

1998,

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1-30** are rejected under 35 U.S.C. 103 (a) as being unpatentable over the public activities of Keane Inc. as of May 5th, 2000 as shown by their web Homepage as of said date and "PRAM it or walk away"; Gray, Neal; Transactions of AACE International; pp: r5-48; 1998. collectively one reference (PRAM)

5. With respect to **Claim 1 and 7, 8, 9 and 10**: PRAM discloses

A computer implemented method for reviewing a business process to identify and address risks, comprising the step of:

providing a business process {see whole document};

identifying risks in the business process as control points {see pg A, iv and v; and pg B, v as soon as the risks are identified and placed on a template they become control points; ie see D, figure 3; this is further supported by the definition of “control point as known in the art and Applicant’s definition found on pg 8, “Control Point” – a risk identified in a business process that should be addressed”}; and

arranging information pertaining to the control points (this is the equivalent to arranging information pertaining to the risks such as what they are and how to mitigate) in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process. {Pg A, PRAM C1, line 7 states the problem was “never written down” and Pg C, (v) 1 page for graphical visualization; and pg D, fig 3 Keane is a consultant/auditor/test entity which conducts tests and consults/audits companies risks and how to address them via an “e-solutions strategy”/action entity and thus implemented on a computer and audits using a template, inherently if made by computer and stored persons will have access; as to newly added matter “occurrence of the risk” See fig 3, given broadest reasonable interpretation of the claimed language, the fig shows a set of tests identifying an occurrence of risks in the business process; ie, Timely Acceptance Sign Off}.

On one hand it could be said that Pram teaches a separate template (pg D) as defined by a line, because a line is separating. Thus it would be a 102 rejection given the broadest reasonable interpretation of the claims because as is shown in the far left column the control points are on a "separate template" because each control point ("risk variables") has its own row, but all the control points are merely on one page.

But one may argue that PRAM fails to teach that there is a separate template for each control point and rather has all of the control points on one page. Because on page C (v) of Pram it states the "all key risks onto one page for easy review and graphical visualization".

However when the prior art teaches all of the limitations except for making separable the steps or components the application's claims are held to be obvious.

Making Separable In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify PRAM to make the separate templates for the control points because case law has held to do so is obvious.

Additionally, this is merely a matter of design choice of the template/s as to keeping separate or combining into one page for easy review and graphical visualization.

6. With respect to **Claim 2 and 9**: PRAM discloses

identifying actions to address the risks {See fig. 3, 2 “Risk Mitigation Action”};

arranging the identified actions in the template {See fig 3, Risk Profile}; and

performing an audit using the template {see whole document, the reason why a user would create a “risk profile” is to perform and audit, this too is where the step of accessing the template occurs, see also pg B, v; “If there isn’t a template, begin making one so that the next time you, or someone else, needs to identify risks you won’t have to start from scratch” This is the same as storing a template in a data base to later use/access again.}.

7. With respect to **Claim 3**: PRAM discloses

step of identifying risks comprises the step of implementing a set of tests to identify risks in the business process {pg B, v and vi; “Identify Risks” and “Determine Probability and Consequence”}.

8. With respect to **Claim 4**: PRAM discloses

(NOTE: As for claim 4, the information on the template is considered to be non-functional descriptive data, see above)

a set of tests, wherein the set of tests identify risks in the business process {fig 3}; and

a set of actions, wherein the set of actions address the risks (fig 3).

9. With respect to **Claim 5**: PRAM discloses

(NOTE: As for claim 5, the information on the template is considered to be non-functional descriptive data, see above)

a business process {See PRAM};

a test entity, wherein the test entity performs the set of tests {See fig 3 and whole document};

an action entity, wherein the action entity performs the set of actions; and audit details {See fig 3 and whole document}.

10. With respect to **Claim 6**: PRAM discloses

(NOTE: As for claim 6, the information on the template is considered to be non-functional descriptive data, see above)

a control point name {pg D, fig 3};

control point revisions { pg D, fig 3};

background information { pg D, fig 3}; and

a control point frequency { pg D, fig 3}.

11. **Claims 10-29** (system, program, method, template) recite the same limitations already discussed above and are rejected on the same analysis.

12. Claims 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over PRAM and the rejection above in further view of Official Notice.

Claims 1-30 are rejected under 35 U.S.C. 103 as being unpatentable over the PRAM reference. The PRAM reference discloses all of the limitations as discussed above; the method in which nearly all consultants analyzing risk normally use and steps and considerations made (ie; id risk, determine how to mitigate, and keep track on a template). PRAM does not discuss the use of the internet and an access field that includes a hypertext link that would allow direct access to a field as claimed. In determining the obviousness of applying what is generally known in the risk consulting

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industry to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site than the first. Using a hypertext link to access such information is widely known by the use of html and linking techniques. Also, the risk consulting industry has utilized computers for years to keep track of accounts and present this data to their customers and employees through GUI's. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet to access the data in one's template/risk profile in a typical risk analysis system such as that taught in the PRAM reference for the purpose of obtaining/editing information. The desirability to do this is clearly to save a customer/employee the time of having to work on paper and pull the template/risk profile each time a user would want to view and or edit the account information; reduce operational costs through more effective information delivery; and improve compliance checking capability. (See Office Action mailed 6/1/2007; In reply to: pg 17 Applicant has traversed Examiners Official Notice that of "inserting a hypertext link into a template to take a user to further information/a new web page" and asserts that it was not well known to one of ordinary skill. Official Notice is proper when it has instantly recallable/ searchable and/or unquestionable. In the present case Examiner went to proquest.com typed in "hypertext and template" before Applicant filing date and instantly found the attached four references. For example in

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"Corel Corp.: WordPerfect Internet Publisher" it is taught WordPerfect is a template (pg 1) and that on tables/templates the program included the option to insert hypertext. Official Notice of the known fact is maintained.)

(10) Response to Argument

In reply to: Applicants assertion that the Dulberg case is not applicable in this case, Examiner respectfully disagrees. Just like the case with a lipstick container with a removable cap, the prior art contained all of the limitations. In the present case the PRAM reference teaches identifying actions to address the risks, arranging the identified actions in a template, and then combining the templates into one document for better visualization (See page D and C(v)). It thus teaches all of the limitations in one piece of art. An just as in the Dulberg case Applicant is attempting to argue without reason that it would not be obvious to one of ordinary skill to disassemble one row and look at it separately or provide in a format in which one row is separate. To this Dulberg lends complete support and certain one of ordinary skill in the art would be motivated to depending on length of details in template look at one row separately in order to focus on the individual control point.

In reply to: Applicant argument that PRAM fails to teach “occurrence of risk” this is not true, and Applicant is asked to look to side #2 of PRAM page D; “Use follow-up meetings to verify *documented* requirements” and then is followed by positive/negative “*Consequence*”.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MB

Conferees:

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